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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/518,534

Filing Date: September 13, 2005

Appellant(s): HAUSER ET AL.

GREGORY J. MAIER
JAMES D. HAMILTON
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03-05-2008 appealing from the Office action mailed
11/16/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 18,20,21,22,26-28,35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dauba.

Dauba marks a glass pane (inherently “smooth”) to identify the treatment temperatures it has undergone by applying a marking substance which changes an optical characteristic in response to the temperature treatment, the substance applied to a glaze (“marking field”) on the pane. The marking (test identification (= “marking stamp”, per claim 27, trademark, reference, etc) is applied by, e.g. screen printing, after a thermal toughening/ tempering step. The marking will irreversibly turn color (e.g. yellow to brown, and is therefore “thermochromic”) if the coated pane undergoes the thermal treatment such as a “heat soak test” (col. 5, 9-25). The marking is **indelible** so there is no risk of marking removal during handling operations (col. 4, 14-38; col. 7, 25-34). The surface of the glaze which is marked inherently possesses a coarser/ less smooth surface than glass; Dauba teaches marking only glazed surfaces, per claim 28. Thus the claims are anticipated by the reference.

Alternatively, the coating surface to which it is applied is not cited to have “uneven surface structure”; however, the film material to which the marking is applied results in the glass being “indelibly marked” (col. 3, 8) and “without risk of the ink being removed during handling operations”. If there was no mechanical bonding/ penetration of the marking material, such markings would be readily removable. Thus, it is the Examiner’s position that the marking material is applied to a film given sufficient porosity/ roughness to be suitable for imparting the indelible properties cited by the reference.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Dauba on a film surface of sufficient structure to allow strong adherence to of the marking material to cause it to be “indelibly marked” and “without risk of the ink being removed during handling operations”.

4. Claims 19,24-25,29 rejected under 35 U.S.C. 103(a) as being unpatentable over Dauba.

Dauba is cited for the same reasons previously discussed, which are incorporated herein. Per claim 29, Dauba teaches a temperature range of 270-330 C which overlaps the temperature range of 180-340 C of claim 29. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the indictable temperature range disclosed by the reference were selected because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Wortheim* 191 USPQ 90. Per claims 24-25, Dauba does not cite an uneven coating surface. However, since Dauba applies similar materials by the same method, e.g. screen printing, the final surface structure would also have been similar. Per claim 19, applying a glaze/ marking field prior to tempering treatment would have been obvious to allow simultaneous thermal treatment of the glaze and glass.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Dauba by using the recited temperature ranges onto an adherent surface because such variations would have been within the purview of one of ordinary skill to achieve equivalent results.

(10) Response to Argument

A. Independent Claims

1. Independent claim 18 (inadvertently marked claim 1 by Applicants on page 4).

Applicants set forth the argument that the marking of their appealed claim 18 "is permanently bonded" to the glass pane, whereas Dauba et al states the marking of their method is "indelibly marked" (col. 3, line 8 and context). It is noted that the word "indelible" is synonymous with "permanent" in the context of resistance to fading. The Examiner reasonably interpreted the limitation "permanantly bonded" to be in view of normal handling or application, and not an infinite time frame or endless set of conditions. Applicants assert, without evidence, the virtually identical marking of the prior art can be removed by a blade or steel wool. The Examiner finds this argument unconvincing because nothing is permanently markable, and he previously challenged Applicants to provide a convincing showing that the claimed marking cannot be removed, e.g. by HF or other acid etching, by a steel blade or chipping by a chisel, by grinding and other conventional means. Applicants own specification, page 6, lines 11-26, indicates their marking can be removed so vestiges may be visible only under magnification. Given the virtually identical processes and materials for the same end-use purpose, the Examiner maintains

that the degree of permanence alluded to by Applicants' claims and Dauba et al would be comparable.

Applicants argue the Examiner's interpretation of glaze on the glass of Dauba and the claimed "marking field" is incorrect. Applicants further contend Dauba only applies a marking substance directly to the glass pane without an intervening marking field which has an uneven surface to receive the marking, see Specification page 4, line 19+. Dauba teaches use of a glazing which may be fixed onto the glass to receive the markings which are an indicator of the "heat Soak Test", see Dauba et al col. 1, 4-15; col. 2, 31-59; etc. Thus the glaze, which inherently possesses a rougher, more grainy structure than the glass (as required by Applicants' claims), is the surface to which the marking substance is applied (see also claim 1 of Dauba et al). Thus claim 18 as presented is not patentable over the prior art.

Applicants newly presented argument that the alternative under 35 USC 103 is improper because the attempted modification in claim 18 would "destroy Dauba et al" for the intended use/ function by permitting removal of the marking under circumstances other than normal handling/ storage to be contrary to US patent practice and procedure, suggesting the rules of Graham v. Deere were not considered, is at best confusing and unclear. The Examiner replies to this position: Dauba cites a glaze surface which is necessarily more textured than glass to which the marking substance is applied, as already stated. Applicants' specification teaches that a rougher/uneven surface relative to the smooth surface of glass improves adhesion. In the coating art, uneven versus smooth is well-known and conventional to improve coating adhesion. "Thus, it is the Examiner's position that the marking material is applied to a film with sufficient porosity/ roughness to be suitable for imparting the indelible properties cited by the reference."

Applicants simply failed to supply evidence, scientific reasoning, or a cogent explanation of their new position.

2. Independent claim 35

Applicants repeated their argument that Dauba directly applies the marking to the glass pane whereas Applicants' claim 35 includes a marking field comprising an uneven surface structure which is filled by the marking color.

The Examiner, for sake of brevity and convenience of the reader, incorporates his rebuttal from two paragraphs above, and further notes that the glaze of Dauba, necessarily being rougher/uneven compared to a smooth glass pane surface, would also receive the marking substance so it fills the glaze surface.

B. The rejection of the defendant claims 19-22,24-29, which depend on independent claim 18, are deemed patentable for the same reasons. In response, the Examiner maintains that claim 18 is unpatentable over Dauba et al, and therefore all defendant claims are equally unpatentable over Dauba et al.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1700

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Frederick J. Parker/

Primary Examiner, Art Unit 1792

Conferees:

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700

/Timothy Meeks/

Timothy Meeks (SPE 1792)